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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GLENN E. RIGGS, JOHN H. KIVELA,
ROBERT H. SHELLMAN, JOSEPH F. ROCKY, JR.,
STANLEY M. BAINOR, RALPH K. BRECHTER, DOUGLAS L. CLARK,
JAMES R. CLARK, JON L. CLOW, AMY DALEY, LARRY HU,
LOUIS F. INDELICATO, WILLIAM J. LOHAN,
MICHAEL M. NAUGHTON, PETER P. NELSON,
ALAND. SHOLLENBERGER, M. NADINE WILLETT,
DOUG JOHNSTON, DONALD H. MUELLER, MICHAEL D. MICHAUD,
ROBERT PHANEUF, and JOSEPH J. BAINOR

Appeal 2013-005548
Application 11/873,969
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants filed a Request for Rehearing asking that the Board reconsider the Decision on Appeal of May 16, 2016. We note at the outset that a Request for Rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). A Request for Rehearing is not an opportunity to rehash arguments raised in the Appeal Brief,

filed February 4, 2013 (“App. Br.”), or in the Reply Brief, filed March 13, 2013 (“Reply Br.”). Neither is it an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. Arguments not raised in the Briefs before the Board and evidence not previously relied on in the Briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) through (a)(4). *Id.*

To the extent the Appellants present supplemental or new arguments in the Request, those arguments are untimely and, as such, will not be considered except where the arguments are based on a recent relevant decision of either this Board or a federal court, or on an allegation that the Board’s decision contains an undesignated new ground of rejection. *See id.*

In the Decision on Appeal, the Board entered a new ground of rejection of claims 9–22 under 35 U.S.C. § 101 but did not reach the prior art rejections.

In this Request, the Appellants argue that we are required to reach the prior art rejections and further that we erred in entering a new ground of rejection under 35 U.S.C. § 101. Appellants request that we consider the prior art rejections and rehear and modify our decision in regard to the new ground of rejection under 35 U.S.C. § 101.

Prior Art Rejection not reached

The Appellants argue that we should have considered and reversed the prior art rejections because (1) failure to reach the prior art rejection deprives the patent of the Patent Term Adjustment to which it is statutorily entitled; (2) failure to reach the prior art rejections needlessly delays the examination of the current application; (3) the Board in U.S. Patent Application No. 11/005,678 (the parent application) decided that prior art applied in that case and also applied in this case is not prior

art; and (4) Arunapuram, relied on in one of the prior art rejections in this case, is not prior art.

The Board's enabling statute, 35 U.S.C. § 6, states in relevant part that "[t]he Patent Trial and Appeal Board shall — (1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a)." 35 U.S.C. § 6(b) (2012). In *ex parte* appeals, the statutory duty of the Board is to "review adverse decisions of examiners." *Id.* By its terms, the statute places no restrictions or conditions on how the Board should review adverse decisions of examiners. *See Berman v. Housey*, 291 F.3d 1345, 1353–54 (Fed. Cir. 2002) (this section addresses "only what issues the Board is empowered to consider, and thus does not establish any affirmative obligations that it must perform").

In *Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984), the Federal Circuit concluded that the United States International Trade Commission ("Commission") "is at perfect liberty to reach a . . . determination on a single dispositive issue." *Id.* at 1423. *Beloit* is persuasive because the Federal Circuit also reviews the Board's final decisions, and the USPTO, like the Commission, is an agency governed by the Administrative Procedure Act ("APA"). As the court further explained, such an approach "may often save the [agency], the parties, and this court substantial unnecessary effort." *Id.*; *cf., e.g., In re Hyon*, 679 F.3d 1363, 1367 (Fed. Cir. 2012) (affirming rejection of all claims under section 103(a) made it unnecessary to reach other grounds of rejection); *In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009) (not reaching other rejections after upholding an anticipation rejection); *In re Basell Poliolefine Italia S.P.A.*, 547 F.3d 1371, 1379 (Fed. Cir. 2008) ("Having concluded that the Board properly affirmed the rejection of [the pending claims] based on obviousness-type double patenting . . . we need not

address the . . . §§ 102(b) and 103(a) rejections, as well as the additional double patenting rejections”).

We further note that our reviewing court has declined to reach alternate grounds of affirmance (examiner rejection) when presented with a 35 U.S.C. § 101 non-statutory subject matter issue — “[w]e do not reach the ground relied on by the Board below — that the claims were unpatentable as obvious . . . — because we conclude that many of the claims are ‘barred at the threshold by § 101.’” *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (quoting *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Similarly, we also note that the Board has had occasion not to reach alternate grounds of affirmance when presented with a 35 U.S.C. § 101 non-statutory subject matter issue. *See Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (precedential).

Therefore, we are not persuaded by Appellants’ arguments that this Board panel erred in declining to reach the prior art rejections. However, in order to avoid piecemeal appeals in this case, we will grant the Appellants’ request and consider the prior art rejections.

Rejection of claims 9–11, 15, and 17

Claims 9–11, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Webmodal in view of Arunapuram.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that Arunapuram is not prior art. Appellants argue that in accordance with the version of 35 U.S.C. § 102(e) in effect at the time of the filing of the instant application, Arunapuram was not prior art. In this respect, Appellants argue that at the time of the filing of the instant application only applications that subsequently became patents granted before the effective filing date of the

application were considered prior art. Appellants reason that because the Arunapuram patent application never matured into a patent, it was not prior art at the time of the invention. App. Br. 5–8. In making this argument, the Appellants recognize that the provision of 35 U.S.C. § 102(e), which defines what constitutes prior art, was amended by the American Inventors Protection Act of 1999 (“AIPA”) so that patent applications which do not mature into patents are considered prior art. However, the Appellants argue that the AIPA did not take effect until November 28, 2000, which is after the July 28, 2000 effective filing date of the instant application. Appellants therefore, conclude that Arunapuram cannot be used as prior art with respect to the present application, i.e., it can only be used as prior art for applications filed on or after November 29, 2000. App. Br. 5–8.

Although the Appellants are correct that the AIPA amendment of 35 U.S.C. § 102(e) to include patent applications as prior art was not effective until November 29, 2000, section 4505 of the AIPA, which amended 35 U.S.C. § 102(e), was further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1903 (2002)). Specifically, § 102(e) was amended to read:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this sub-section of an application filed in the United States only if the inter-national application designated the United States and was published under Article 21(2) of such treaty in the English language; or.

Section 4508 of the AIPA, i.e., the “Effective Date,” also was amended to explicitly extend the applicability of section 4505 of the Act (and, therefore, the applicability of § 102(e), as amended) to “all patents and all applications for patents pending on or filed after November 29, 2000.”

Appellants claim an effective filing date of July 28, 2000 based on a provisional application. However, the instant application was still pending on November 29, 2000; as such, the application is subject to the provisions of the AIPA, as amended. Therefore, we agree with the Examiner that Arunapuram can properly be relied on as prior art.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that Arunapuram is not entitled to the filing date of the provisional application because the relied on portions of the Arunapuram reference are contained in the appendix to the Arunapuram provisional application. Appellants argue that the relationship of the Arunapuram provisional application to the documents that appear in the appendix is never indicated in the Arunapuram provisional application. App. Br. 9. We do not agree; the Arunapuram provisional application at page 2 clearly states that “[t]he invention will best be described in further detail with regard to its various aspects within the following ten appendices” and, therefore, we agree with the Examiner that Arunapuram’s provisional application includes the two-page disclosure as well as the appendices, which more fully explain the invention, and that the entire document can be considered in determining patentability.

We are not persuaded of error on the part of the Examiner by Appellants’ arguments that the Arunapuram appendices are confusing and insufficient to a person of ordinary skill. We presume that this argument is an argument related to the enablement of the Arunapuram reference. However, this argument is not

entitled to substantial weight because it is not supported by evidence refuting the presumption that the Arunapuram reference is enabling. *See In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012).

We agree with the Examiner's response to the various arguments of the Appellants in response to this rejection found on pages 4–8 and adopt the Examiner's response as our own.

Specifically, we are not persuaded of error on the part of the Examiner in this rejection because the Arunapuram appendices contain different dates and different versions and numerous external references. Instead, we agree with the Examiner that the different dates on the appendices are not relevant because upon filing of the appendices as part of the Arunapuram provisional application, these appendices were recognized for their collective teachings with a priority filing date of June 16, 2000, which is the filing date of the Arunapuram provisional application. In addition, as the Appellants have not directed our attention to how the different versions of the appendices differ or even specifically identify these different versions, this argument is not persuasive.

We are not persuaded of error on the part of the Examiner by Appellants' argument that one of ordinary skill in the art would not attempt to modify Webmodal in the manner proposed in the rejection. Appellants argue that the object of the Webmodal method is to select a carrier based on price and schedule without regard to or knowledge of how the selected carrier will route the shipment and that there is no indication that a carrier ever provides its routing details for shipment. Appellants further argue that the Examiner does not provide a reason why a person of ordinary skill in the art would modify Webmodal to display routing options and ask its customers to select among different routing options rather than simply selecting a carrier with the best schedule and price.

We agree with the Examiner that claim 9 does not require that the customer select routing options among different routing options. In fact, claim 9 does not recite who is performing the various steps of the method. As such, claim 9 is broad enough to cover a method in which a customer or a shipper or any other party performs the steps of the method. We also agree with the Examiner that as Arunapuram discloses that the best priced route can be determined, a person of ordinary skill in the art would have had a reason to modify the Webmodal method so as to use this pricing information to determine the best route to ship the goods.

In view of the foregoing, we will sustain this rejection as it is directed to claim 9. We will also sustain the rejection as it is directed to claims 10, 11, 15, and 17, which depend from claim 9, because the Appellants have not advanced arguments about the separate patentability of these claims.

Rejection of claims 12–14, 16, and 18–22

Claims 12–14, 16, and 18–22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Webmodal, Arunapuram, and Lettich.

We are not persuaded of error on the part of the Examiner by Appellants' argument that Lettich is not prior art for the same reasons argued in regard to the Arunapuram reference. We will sustain this rejection because we hold that Lettich is prior art for the same reasons given above in our discussion of the prior art status of the Arunapuram reference.

In view of the foregoing, we will sustain this rejection.

Rejection under 35 U.S.C. § 101

In the Decision on Appeal, the Board entered a new ground of rejection under 35 U.S.C. § 101 holding that the claims are directed to an abstract idea. In the Appellants' request for rehearing, the Appellants argue that this rejection was

in error because we failed to identify the abstract idea. This is not correct. We clearly stated on page 5 of the Opinion that claim 9 is directed to the abstract idea of determining the best carrier and route to use to ship goods and scheduling shipment based on the carrier and route information.

Appellants also argue that we erred by holding that the method could be performed by human thought alone because the claims recite “via a computer.” However, as we said on page 6 of our Decision, the recitation of “via a computer network” is not enough to transform the ineligible abstract idea into patent eligible subject matter because this recitation amounts to no more than implementing the abstract idea using a computer.

DECISION

On the record before us, Appellants’ Request for Reconsideration is GRANTED in that we modify our original decision to include an analysis of the prior art rejections and an affirmation of the prior art rejections. We decline to make any other modifications to our decision.

As the Decision on Request for Rehearing modified the original decision so as to include an analysis and conclusion regarding the prior art rejections, pursuant to 37 CFR § 41.52(a)(1), a second request for rehearing is permitted.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED